

Applicant: Hohenthalner, *et al.*

Serial No.: 10/562,994

Filing Date: November 6, 2006

October 8, 2009 Response to August 27, 2009 Restriction Requirement

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REMARKS

The present application has claims 1-20 pending.

In an August 27, 2009 Restriction Requirement, the Examiner restricted the claimed invention among two allegedly distinct groups:

“Group I, claim(s) 1-10, drawn to a method of making (sic) with perforation defined as layer with plurality of holes across the planar field.

Group 2, claim(s) 11-18, drawn to a method of forming a MEA requiring the removal of the second support film.

Claims 19-20 can be joined to either group 1 or group 2 ...” (August 27th Restriction, pg. 2, para. 1).

The Examiner maintains that “[t]he inventions listed as Groups I (sic) do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The rejection previously submitted by Kohler and Puffer in the action filed 11/28/2008 teaches the limitations of claim 1 as well as claim 11. The examiner does not find the argument about Puffer being unusable as prior art as persuasive and therefore upholds this art as teaching that limitations of claim 1 and 11 are thusly met. The dependant claims of these species diverge where group 1 focuses on the perforation and group 2 focuses on lifting of the supporting foil.” (*Id.*, pg. 2, para. 2).

Applicants do not understand the restriction requirement or the Examiner’s comments. Of its face, the restriction between claims 1-10 and claims 11-18 appears not to be legally correct. Moreover, the comments are factually and legally incorrect.

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Claims 11-18 are dependent claims that depend from claim 1. Applicants do not understand how claims 11-18 can be directed to a different invention than that of claim 1 when they contain all the limitations of claim 1.

Claim 1 requires, *inter alia*, that the “membrane is connected with at least one supporting foil during at least all coating steps....” Claim 11 requires, *inter alia*, that the back side of the membrane have a supporting foil while the front side is coated (claim 11, clause a) and that a second supporting foil be applied to the front side of membrane and the foil on the back of the membrane be removed before the back side of the membrane is coated (claim 11, clauses b, c and d) -- that is, the membrane in claim 11 is connected with at least one supporting foil during the coating steps as required by parent claim 1 from which it depends.

Claims 11-18 are simply preferred embodiments of the invention of claim 1. All the pending claims of the application possess the same special technical features and relate to a single general inventive concept pursuant to PCT Rule 13 -- that is, the membrane being connected with at least one supporting foil during the coating steps.

The Examiner’s characterization of Group 2 as “a method of forming a MEA requiring the removal of the second support film” is not understood since claim 11 does not require the removal of a second support film or foil.

Additionally, the Examiner’s comments concerning the Puffer reference are not understood. When rejecting an application, the Examiner has the burden of citing proper prior art. As Applicants noted in their last response, the Puffer reference is not prior art to the present application since the reference has an effective date of August 20, 2003 -- **almost two months after the June 27, 2003 priority date of the present application.**

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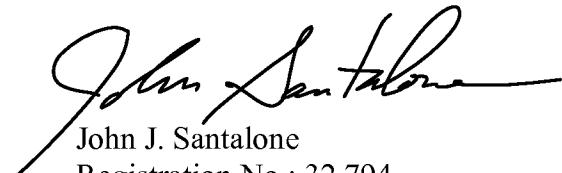
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The Examiner's response that he "does not find the argument about Puffer being unusable as prior art as persuasive and therefore upholds this art as teaching that limitations of claim 1 and 11 are thusly met" is not understood by Applicants. Applicants did not present an argument on the Puffer reference that needs to be persuasive -- Applicants simply made the observation that Puffer is not prior art to the present application. If the Examiner insists on using the Puffer reference as a basis for rejection, the Examiner is requested to provide his reasons for believing that the Puffer reference is proper prior art.

Although Applicants believe that the proper course of action in the present prosecution is the withdrawal of the August 27th Restriction Requirement, for the sake of completeness Applicants elect claims 1-10 for prosecution at the present time if the restriction is not withdrawn.

No fee is believed to be required in connection with the filing of this response, other than the fee for the requested one-month extension of time. If any other fee is deemed necessary, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 11-0171. If the Examiner has any questions regarding the present application, the Examiner is cordially invited to contact Applicants' attorney at the telephone number provided below.

Respectfully submitted,



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